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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,332	12/08/2003	John W. Rohrer		5081

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 08/19/2004

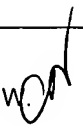
Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/731,332

Applicant(s)

ROHRER, JOHN W. 

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4, 7, 8, 11 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 9, 10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I (Type)

- a. Species 1 (Fig. 2A): 3, 5, 9, and 12-13
- b. Species 2 (Fig. 2B):
- c. Species 3 (Fig. 2C):
- d. Species 4 (Fig. 3A):
- e. Species 5 (Fig. 3B):
- f. Species 6 (Fig. 3C):
- g. Species 7 (Fig. 4A):
- h. Species 8 (Fig. 4B):
- i. Species 9 (Fig. 6A):
- j. Species 10 (Fig. 6B):
- k. Species 11 (Fig. 6C):
- l. Species 12 (Fig. 7A):

Group II (shape of element)

- a. symmetrical: Claim 6

b. elongated: Claim 7

Group III (manufacturing)

a. slip on (Fig. 1): Claim 10

b. wrap on (Fig. 5): Claim 11

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, it appears that claims 1-2 is generic to all embodiments.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. John W. Rohrer on 13 August 2004 a provisional election was made without traverse to prosecute the invention of species 1 of Groups I, II and III which is the embodiment of figure 2A with the grip being a slip on grip with the shape as defined in claim 6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4, 7-8, 11 and 14-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "said softer elastomeric material " in line 3. Claim 13 recites the limitation "the surface of said softer grip materials" in lines 1-2. There is insufficient antecedent basis for these limitations in

the claims since they were not previously disclosed. The examiner recommends replacing the words "said" and "the" with the word -- a --.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Turner.

Turner discloses a putter (Col. 4, Lns. 20-25) or other golf club grip (Col. 4, Lns. 25-33) with vibration transmission from the shaft to a player's hand (Col. 3, Lns. 41-47) via one hard or rigid vibration transmitting elements in the form of a metal grip (Col. 4, Lns. 33-56, Ref. No. 1) into intimate contact with both rigid extensions from a shaft in the form of metal collars (Col. 10, Lns. 18-20, Ref. Nos. 13-14) and a player's hand (Fig. 2), an element being ring shaped in a circumferential dimension (Fig. 10).

7. Claims 1-3, 5-6, 9-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Downey.

Downey discloses a golf club grip (Title) with vibration transmission from the shaft to a player's hand via one hard or rigid vibration transmitting elements in the form

of a jacket formed of stiff material (Col. 3, Lns. 57-60) of metal (Col. 4, Lns. 11-13) and relatively incompressible (Col. 5, Lns. 37-40) into intimate contact with both a shaft and a player's hand (Fig. 6), an element being an other symmetrical shape in the form of a triangle (Fig. 5), a grip area around an element having a layer of softer grip material (Col. 9, Lns. 55-60), an element being embedded through a softer rubber (Fig. 6, Col. 4, Lns. 3-12), a slip-on type grip (Fig. 5), and an element is flush with a surface of a softer grip material (Fig. 6).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Downey in view of Kobayashi.

Downey lacks an element being attached to a shaft prior to placing a softer elastomeric material around an element. Kobayashi discloses attaching an inner jacket prior to placing a softer elastomer material around the inner jacket (Col. 3, Lns. 42-49). In view of the patent of Kobayashi it would have been obvious to modify the grip of Downey to have an element being attached to a shaft prior to placing a softer elastomeric material around an element in order to simplify the assembly process by not

having to use a mandrel and then take the grip off a mandrel and then place it on a shaft.

### ***Response to Arguments***

10. The argument that it is improper to use the reference of Downey (5,261,665) since it is for full impact clubs and not putters is disagreed with. The claims do not limit the club to a putter. Claim 1 allows for other golf club in addition to a putter (line 1). Never the less the advantages of Downey would also benefit a putter club also. In addition claim 1 only claims a grip and not a club. Clearly the grip of Downey is able to be used for a putter. The argument that Downey does not utilize vibration conducting material is disagreed with. Downey allows the use of metal which clearly will conduct vibrations. The argument that Turner (5,575,473) does not disclose a rigid conducting pathway is disagreed. Both the grip and collars are able to be made of metal which is a rigid conducting pathway for vibrations. The argument that it is improper to use the reference of Turner since it is for full impact clubs and not putters is disagreed with. Turner clearly discloses use for putters (Fig. 1, Col. 4, Lns. 20-25). In addition, the claims do not limit the club to a putter.

**Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kunihisa discloses a handle for a golf club with vibration sensing means.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 16 August 2004

  
**STEPHEN BLAU**  
**PRIMARY EXAMINER**